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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,973	02/18/2004	Ilya Ostrovsky	DNAG-278 (10402028)	1039
24972 7590 10/18/2007 FULBRIGHT & JAWORSKI, LLP 666 FIFTH AVE NEW YORK, NY 10103-3198			EXAMINER LEADER, WILLIAM T	
			ART UNIT	PAPER NUMBER
			1795	
			MAIL DATE	DELIVERY MODE
			10/18/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/781,973	Applicant(s) OSTROVSKY, ILYA	
	Examiner William T. Leader	Art Unit 1795	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 63-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 63-73 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>attached</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. Receipt of the papers filed on August 2, 2007, is acknowledged. Claims 1-62 have been canceled. New claims 63-73 have been presented.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 103

3. Claims 63-73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan (6,916,414) in view of Schaedel (4,152,221) for the reasons of record and in view of the following comments.

Double Patenting

4. Claims 63-73 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,875,334 in view of Kinase et al (4,416,742) for the reasons of record and in view of the following comments.

Response to Arguments

5. New claims 63-73 closely correspond to previously examined claims 32-42. Applicant's Remarks have been carefully considered but are not deemed to be persuasive. At page 5 of the response, applicant contends that in the list of substance classes of column 2 of the Dolan patent, a), b) and i) are phosphorus oxysalts, silicon oxysalts and alkali metal hydroxides. Applicant

argues that surfactants, alcohols, and alkaline hydrolyzed silanes are not mentioned. However, as pointed out in the previous office action, Dolan discloses that the anodizing solution may contain a water-soluble amine such as an alkanolamine. See column 4, line 63 to column 5, line 27. It is noted that paragraph [0027] of applicant's specification discloses that the claimed alcohol may preferably be a mono-, di-, or tri-alkanolamine. Thus, Dolan does disclose all constituents of the bath recited in instant claim 63 except for a surfactant.

6. The Schaedel patent was relied on in the rejection to show the inclusion of a surfactant in an anodizing solution. Schaedel teaches that the anodizing solution preferably contains a surfactant that acts as a surface acting wetting agent which forms a complex with the part being processed. See column 6, lines 38-52. Applicant notes that the surfactant of Schaedel causes the formation of foam, and argues that the surfactant added to the solution of the present application should not create foam. This argument is not persuasive because the presence or absence of foam is not recited in the claims, nor does it appear to have been discussed in the specification.

7. With respect to the double patenting rejection, applicant observes that triethanolamine may be one of the alcohols which is used in the present invention for the stabilization of the gel for the polymeric layer, and argues that hydroxylamine would not work as a stabilizer in the solution of the process of the present application, and that the Examiner has not considered the use of the respective components. This argument is not persuasive because neither a gel nor a polymeric layer is recited in the claims. Thus, the claims are not limited to the specific use argued by applicant.

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8. In the previous office action it was noted that claim 42 contained the expression "e.g." which was interpreted to mean "for example". The subject matter appearing after "e.g." was considered to be exemplary but not limiting. New claim 73 corresponds to original claim 42. Line 4 of claim 73 includes the expression "like". As is the expression "e.g.", the expression "like" is interpreted to mean "for example". The subject matter appearing after "like" is considered to be exemplary but not limiting.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William T. Leader whose telephone number is 571-272-1245. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays, 7:30-4:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Susy Tsang-Foster can be reached on 571-272-1293. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

WL

William Leader
October 11, 2007

Susy Tsang-Foster
SUSY TSANG-FOSTER
PRIMARY EXAMINER